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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,043	04/03/2000	BERND EIKMANN	21437	6651

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EXAMINER

STEADMAN, DAVID J

ART UNIT	PAPER NUMBER
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1652

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DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/529,043

Applicant(s)

EIKMANN'S ET AL.

Examiner

David J Steadman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 64-65, 70-78 and 81-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 64, 65, 70-78 and 81 is/are allowed.
- 6) ☒ Claim(s) 82, 85 and 86 is/are rejected.
- 7) ☒ Claim(s) 83 and 84 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

- [1] Claims 64-65, 70-78, and 81-86 are pending in the application.
- [2] Applicants' amendment to the claims filed June 10, 2003 is acknowledged. This listing of the claims replaces all prior versions and listings of the claims in the instant application.
- [3] The text of those sections of Title 35 U.S. Code not included in the instant action can be found in a prior Office action.
- [4] The finality of the Office action mailed April 09, 2002, is withdrawn.

Interference

- [5] It is noted that applicants have declared an interference between the claims of the instant application and the claims of US Patent 6,171,833 (see page 6 of the amendment filed July 12, 2001). The claims of the instant application and US Patent 6,171,833 ('833 Patent) are drawn to polynucleotides, vectors, host cells, and methods of making a polypeptide. Furthermore, the examiner advised applicants to copy the claims of US Patent 6,403,351 in order to add the claims in the instant application (acknowledged by applicants at page 4-5 of the amendment filed June 10, 2003). The claims of US Patent 6,403,351 are drawn to the polypeptide encoded by the polynucleotide of the '833 Patent. Alignments of SEQ ID NO:1 and 2 of the instant application with SEQ ID NO:1 and 2 of US Patent 6,171,833 are provided at the end of this Office action. It should be noted that the initiation codons of SEQ ID NO:2 of the

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instant application and US Patent 6,171,833 are GTG and not ATG-encoded methionine and an alignment of SEQ ID NO:2 of the instant application with SEQ ID NO:1 of US Patent 6,171,833 would suggest that SEQ ID NO:1 of US Patent 6,171,833 encodes a polypeptide that is structurally distinct from SEQ ID NO:2 of the instant application. However, it is known in the art that a GTG initiation codon occurs in bacteria. For example, Wolf-Dieter Deckwer et al. ("Biotechnologie and Gentechnik", Georg Thieme Verlag, Stuttgart, Germany, 1999) teach that about 8% of prokaryotic genes have GUG as an initiation codon (pages 320 and 749). The interference has been held in abeyance until the claims are in condition for allowance.

Claim Rejections - 35 USC § 112, First Paragraph

[6] Claim(s) 82 and 85-86 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

Claims 82 and 85-86 recite the limitation "'pyruvate carboxylase polypeptide... encoded by the clone contained in ATCC Deposit No. PTA 982". There is no support in the specification, claims, or drawings as originally filed for this limitation. Applicants are invited to direct the examiner's attention to such support.

Conclusion

[7] Status of the claims:

- Claims 64-65, 70-78, and 81-86 are pending.
- Claims 82 and 85-86 are rejected.
- Claims 83-84 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- Claims 64-65, 70-78, and 81 appear to be in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:00 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for submission of official papers to Group 1600 is (703) 308-4242. Draft or informal FAX communications should be directed to (703) 746-5078. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.
Patent Examiner
Art Unit 1652

DS 01-13-04
DAVID STEADMAN
PATENT EXAMINER